IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Kolar, Bradley D. et al.	Examiner: Sterrett, Jonathan G.
Application No.: 10/665,179	Group Art Unit: 3623
Filed: September 17, 2003	Docket No.: 33836.03.0004
For: EDUCATION PRODUCT EVALUATION METHOD AND APPARATUS	

APPELLANTS' REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Dear Sir:

In the above-identified application, Appellant submits this Reply Brief in response to the Examiner's Answer mailed February 14, 2011 ("the Answer") that in turn is in response to Appellant's Appeal Brief filed December 3, 2010 ("the Appeal Brief").

I. Appellants' Reply

A. Claims 1-47

1. Appellant's argument that the cited references fail to teach the claimed limitation of "business goal rule data representing a business organization's goals with respect to employee training"

Appellant has noted the responses in the Answer ("Response to Argument" section, pages 21-26) to Appellants' argument that cited references (including Officially Noticed material) fail to teach "business goal rule data representing a business organization's goals with respect to employee training." Appeal Brief, page 17-19.

In this regard, the Office first states:

> [T]here's no positive recitation in the claim that the business goal rules are in fact formulas that are used to evaluate software. The claims cite that the evaluation is performed . . . 'based on the business goal rules'. This reliance is indefinite because it is not clear how the generation is 'based on the business goal rules'. (Answer, p. 21)

In response, Appellant initially notes that Appellant has never presented arguments that "the business goal rules are . . . formulas that are used to evaluate software", nor is Appellant aware of any requirement that the claims must positively recite such formulas. It would appear that the Office is requiring the claims to be enabling, which is, of course, not a requirement of the claims. Such enablement is properly found in the specification, not the claims. *See* M.P.E.P. §§ 2164, 2164.05. Furthermore, the Office appears to suggest that this limitation is indefinite, which would of course constitute new grounds of rejection. As no such grounds have been set forth (as required by 37 C.F.R. § 41.69(b)), and because the Office nevertheless found adequate support in the specification for this recitation (Answer, p. 22-23), Appellants make no response.

Appellants have noted the further assertion in the Answer that "it is the combination of the Official Notice [that it is well known for businesses to have goals with respect to employee

training] and the teachings of Lawlis that render the [business goal rule data representing a business organization's goals with respect to employee training] limitation obvious." Answer, p. 26. In response, Appellants first note that the Office's focus on the obviousness of this limitation violates the rule that the subject matter as a whole is to be considered for obviousness. 35 U.S.C. § 103(a); *see also*, M.P.E.P. § 2141.02(I) ("In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (emphasis in original)).

Furthermore, the combination of the Officially Noticed material and Lawlis appears to be little more than hindsight analysis. Per M.P.E.P. §2142, the conclusion of obviousness "must be reached on the basis of the facts gleaned from the prior art." That is, a conclusion of obviousness is proper "so long as it takes into account only knowledge which was within the level of ordinary skill in the art . . . and does not include knowledge gleaned only from applicant's disclosure . . . ." M.P.E.P. § 2145(X)(A). In the instant case, the only apparent source of the teaching to employ "business goal rule data representing a business organization's goals with respect to employee training" is the instant application. While Applicants acknowledge that "any judgment of obviousness is in a sense necessarily a reconstruction based on hindsight reasoning" (Id.), Appellants respectfully submit that the alleged combination does not "take into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made" and instead bases this conclusion on "knowledge gleaned only from applicant's disclosure." Indeed, the "predictable result" alleged in the Appealed Office Action and repeated in the Answer (p. 6) results only from a prior appreciation of what Appellants have disclosed, there being no suggestion provided as to *why* it would be desirable to modify Lawlis'

"business goal rule data" according to a business organization's goals with respect to employee training. As such, Appellants once again submit that the rejection of the instant claims on this basis is improper.

Finally, Appellants respectfully reassert the other arguments presented in the Appeal Brief. In particular, it is noted that the Answer fails to provide any response to Appellants' arguments (i) that the Office's rationale for rejecting the claims on the basis of descriptive material/printed matter is erroneous and (ii) that the Office's reliance on arguments concerning the similarity of "functionality" is likewise erroneous.

II. Conclusion

For the reasons advanced above, Appellants submit that the Office erred in rejecting appealed claims 1-47 and request reversal of same.

Respectfully submitted,

/Christopher P. Moreno/

Date: April 13, 2011 By: _____

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